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ART UNIT	PAPER NUMBER
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 11

Application Number: 09/319,326
Filing Date: June 03, 1999
Appellant(s): KRANAWETTER ET AL.

Ronald H. Kurdyla (#26,932)
For Appellants

EXAMINER'S ANSWER

This is in response to the appeal brief filed as Paper 10 on 10/22/02.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement is present identifying that there are no related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendments after final have been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellants' statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellants' brief includes a statement that claims 1-17 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). The Examiner concurs with the grouping of Appellants' claims on appeal.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,701,160	Kimura et al.	12-1997
6,028,635	Owen et al.	2-2000

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura et al., (hereinafter referred to as "Kimura") in view of Owen et al., (hereinafter referred to as "Owen"). This rejection is set forth in prior Office Action, Paper Number 8 mailed on 5/20/02.

(11) Response to Argument

Appellants' arguments filed with respect to claims 1-17 as filed in Paper 10 have been fully considered but they are not persuasive. The Appellants present three arguments contending

the Examiner's rejection of claims 1-17 are under 35 U.S.C. 103(a) as being unpatentable over Kimura et al., (hereinafter referred to as "Kimura") in view of Owen et al., (hereinafter referred to as "Owen"), as was set forth in the prior Office Action of Paper Number 8 mailed on 5/20/02. However, after careful consideration of the arguments presented, the Examiner must respectfully disagree and submit to the Board that the rejection applied is proper and should be maintained.

After reiterating the proper basis for applying a 35 U.S.C. 103(a) rejection (Paper 10: page 4, lines 1-16), the Appellants argue that Kimura fails to disclose "...recompressing a datastream prior to storage in memory..." as claimed (Paper 4: page 4, lines 20-31; page 5, lines 1-6). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In particular, the Examiner notes that the "...recompressing a datastream prior to storage in memory..." feature is met by the secondary Owen reference (Owen: column 8, lines 59-68; column 9, lines 1-15), and thus the combination of it with the Kimura teaching would address the feature as claimed. Additionally, it appears to the Examiner that the Appellants now concur with the Examiner's view that Kimura stores decoded reference data into the shared memory (Paper 10: page 4, lines 20-24), which was different from the position communicated to the Examiner in prior stages of prosecution as the Appellants erroneously concluded that Kimura did not store any data in the shared memory but only retrieved data from the stored memory (Paper 7: page 7, lines 7-13).

Secondly, the Appellants argue that combination with Owen would not be obvious because it would defeat Kimura's concerns with providing a circuit with a small size, low cost,

and high processing speeds because bodily incorporation of the Owen reference would increases components and size (Paper: page 5, lines 7-26). The Examiner vehemently disagrees. The Owen reference discloses that through the use of invention disclosed therein the following advantages are realized: significant cost reduction (Owen: column 5, lines 53-55) without a significant increase in the die area of the decoder (Owen: column 5, lines 62-64) with the simultaneous gain of high processing speeds (Owen: column 5, lines 57-59). This means that even with the addition of more components, the decoder size of Owen and thus Kimura would not increase because it is offset by the die space created through the reduction of the shared memory size (Owen: column 5, lines 50-52). So contrary to the Appellants' misinformed assertion (Paper 10: page 5, lines 23-26), Owen does not teach away from a combination with Kimura, but reinforces the aims of the Kimura reference as discussed above.

Lastly, the Appellants argue that Owen fails to disclose "...concurrently operative processors..." as in the claimed invention (Paper 10: page 5, lines 27-35; page 6, lines 1-4). The Examiner respectfully disagrees. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In particular, the Examiner notes that the "...concurrently operative processors..." limitation is met by the primary reference (Kimura: column 16, lines 1-15), and thus the combination of it with the Owen teaching would address the feature as claimed.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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